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| EXAMINER |
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SPISICH, MARK

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| ART UNIT | PAPER NUMBER |
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3723

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09/19/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/036,022 | <b>Applicant(s)</b><br>ROBERTS ET AL. |  |
|                              | <b>Examiner</b><br>Mark Spisich      | <b>Art Unit</b><br>3723               |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 52-54 and 57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 52-54 and 57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |



## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6 August 2008 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 52-54 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 1-72128 (hereinafter '128). '128 discloses an oral brush comprising an elongated handle (3), head portion (1) as well as a brush portion comprising at least one elastomeric element (2) comprising a styrenic block copolymer (see page 6 of exhibit "B" filed 4 October 2004) thermoplastic elastomer and further including a plurality of conventional non-elastomeric bristles in a center portion of the head (see page 5, line 28 of the translation attached to '128) with the elastomeric bristles/elements being at the side portions of the brush portion (claim 3). '128 discloses the invention substantially as claimed with the exception of the Shore A hardness being "less than 55". The example

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given in the specification for the preferred material in the recited category is a known material (KRATON, page 7, line 1). It is not unreasonable to assume that an elastomer in this class of materials having the recited hardness exists under the trademark KRATON. In addition the prior art device is also used in the same environment and that one of ordinary skill would well be aware of hardness values that would be appropriate for use in a user's mouth (it's not like the prior art is for an entirely different purpose). It would have been obvious to one of ordinary skill in the art at the time the invention was made to select a KRATON having an appropriate hardness in the recited range, since it has been held to be within the general skill of a worker in the art to select a known material in the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. With regard to the term "molded", the materials of the present application are also extruded or molded. In addition, **the present specification (eg, page 3, lines 21-25) describes the category of materials known as "thermoplastic elastomers" as materials which can be processed by conventional plastics processing methods which are well known in the art, such as extrusion or injection molding.**

#### ***Response to Arguments***

4. Applicant's arguments filed 6 August 2008 have been fully considered but they are not persuasive. Most of applicant's remarks deal with the term "molded", in addition to a comment regarding the recited hardness. With regard to the hardness, '128 discloses a thermoplastic elastomer that it used to comprises elastomeric elements on an oral care implement of the type claimed in the present application (i.e. a brush with

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both elastomeric elements/bristles and conventional non-elastomeric bristles for uses in cleaning teeth and gums). There is nothing in the specification which would suggest that the selection of the hardness is a critical part of the invention. The application merely gives an exemplary value. Any prior art device would have any number of properties and the mere fact that it is silent with regard to a number of properties does not make it patentable to simply list a property thereof. The elastomer material of the prior art is also used in the same environment (contacting the user's teeth and gums). The use of the particular hardness was not selected in a vacuum from all the possible materials known in the world, but instead one of ordinary skill would deem it obvious (based on common sense) to select materials which would be comfortable and useful for the intended use (which would not damage the gums, etc.). Also, a prior art reference need not have a molded element to meet a claim that recites that the element is "molded". It only has to be made of a material which is capable of being molded (within the broadest sense of the term). In addition, **applicant's own specification stated that the materials of the type known as "thermoplastic elastomers" (one of which is taught by '128) can be processed by conventional plastics processing methods which are well known in the art, such as extrusion or injection molding** (see page 3, lines 21-25). The main argument that has been repeated in this application pertains to the term "molded" in describing the elastomeric element(s) in claim 52. Applicant states in the specification (page 3) that thermoplastic elastomers can be formed or processed by any known processing method. The fact that '128 discloses a different method of forming the elements does not overcome the fact that

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the elastomeric elements could be formed by other means as well, given the fact that the claims are to the brush and not to a method of forming it. There is no indication or suggestion in the specification that the manner of forming the elastomer elements constituted any part of the invention and that the method of forming produced anything but results that would be expected by one of ordinary skill. The entire application pertains to the use of thermoplastic elastomers with the disclosure of a number of exemplary materials that may be used. Applicant state on page 3 (lines 21-25) that these materials are capable of being processed by conventional plastics processing methods which are well known in the art. Going back to the hardness, if the prior art device applied against the claims was used for an entirely different purpose (i.e. totally different than an oral brush), then the selection of a known KRATON material that would be useful in an oral environment might not be "as obvious". Given that '128 is used for the same purpose, the selection of materials having a hardness which would not harm the user's teeth and gums would amount to an obvious choice of design in that it would be common sense to select a known material that would be useful for the intended use and which would function in the environment addressed by the prior art.

### ***Response to Amendment***

5. The declaration under 37 CFR 1.132 filed 6 August 2008 is insufficient to overcome the rejection of claims 52-54 and 57 based upon Japan 1-72128 as set forth in the last Office action because: The declaration of Craig Masterman has been reviewed and fully considered by the examiner. The declaration (in paragraphs 2 and 3) makes the statement that the inventions "discovered that extrusion did not work well for

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forming elastomeric elements" (paragraph 2, lines 2-3) and that the use of "molded elastomeric elements exhibited better wear resistance" (paragraph 3, lines 1-2).

Looking to the specification (page 3, lines 21-25), it states "The term "thermoplastic elastomer", as used herein, refers to non-vulcanized, rubbery polymeric materials which **may be processed by conventional plastics processing methods which are well known in the art, such as extrusion or injection molding**". This statement contradicts the statement in the declaration with regard to the criticality of the method of forming the elastomeric elements. The statement in the specification states that the materials falling within the genus of "thermoplastic elastomers" (and which the elastomer material of 1-72128 is included) may be formed by either extruding or molding. In a claim to a product, the elastomer or the prior art need only be capable of being molded and not necessarily be disclosed as such.

### ***Conclusion***

6. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within



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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Spisich whose telephone number is (571) 272-1278. The examiner can normally be reached on M-Th (5:30-3:00), Alternate Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark Spisich/

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/M. S./

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